

REMARKS

Claims 2-7 are pending in the application. In the Office action dated November 6, 2007, claims 2-7 were rejected and claims 2 and 4 were objected to. In response to the Office action dated November 6, 2007, Applicant has amended claim 4 and added new claim 8.

In view of the amendments above, and the remarks below, Applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111.

Objections to the Claims

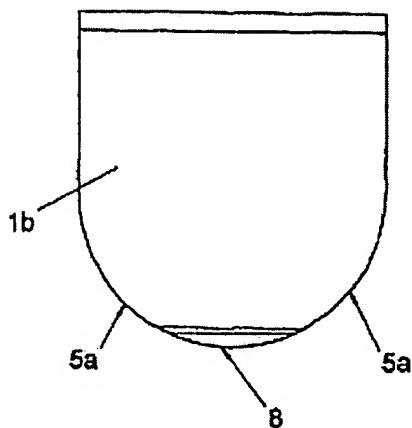
The Examiner has objected to claims 2 and 4.

With respect to claim 2, the Examiner asserts that the claim element "the fold line" in the seventh line has insufficient antecedent basis. Applicant notes that the claim element "the fold line" does not appear in claim 2, and suggest that the Examiner is referring to pending claim 4. Applicant has therefore amended claim 4 to provide sufficient antecedent basis for "the fold line".

With further respect to claim 4, the Examiner asserts that the claim element "at each limb vertex" renders the claim indefinite because it is unclear what corresponds to each limb vertex. Applicant respectfully suggests that the meaning of the term "vertex" would be known to one of ordinary skill, that is, the point on a geometric figure that is opposite to and furthest away from its base. This definition is further reinforced by the specification, which indicates that the inwardly curved folds are arranged at an acute or obtuse angle with respect to the back of the clip or "in the region of the vertex 8 of the two limbs 1b (Fig. 5)" (see page 2, lines 14-15). The meaning of the vertex of the limb is further clarified in Fig. 5, which shows vertex 8 at the point on the limb furthest from the

base (see below).

Fig. 5



However, in the interest of furthering the prosecution of the application, Applicant has amended claim 4 to more particularly define their invention. Specifically, they have amended the claim to recite the fold line being disposed at an acute angle (4a) with respect to the back, or the fold being disposed at the region of each limb furthest from the back. Applicant suggests the scope of the claim is both particular and definite.

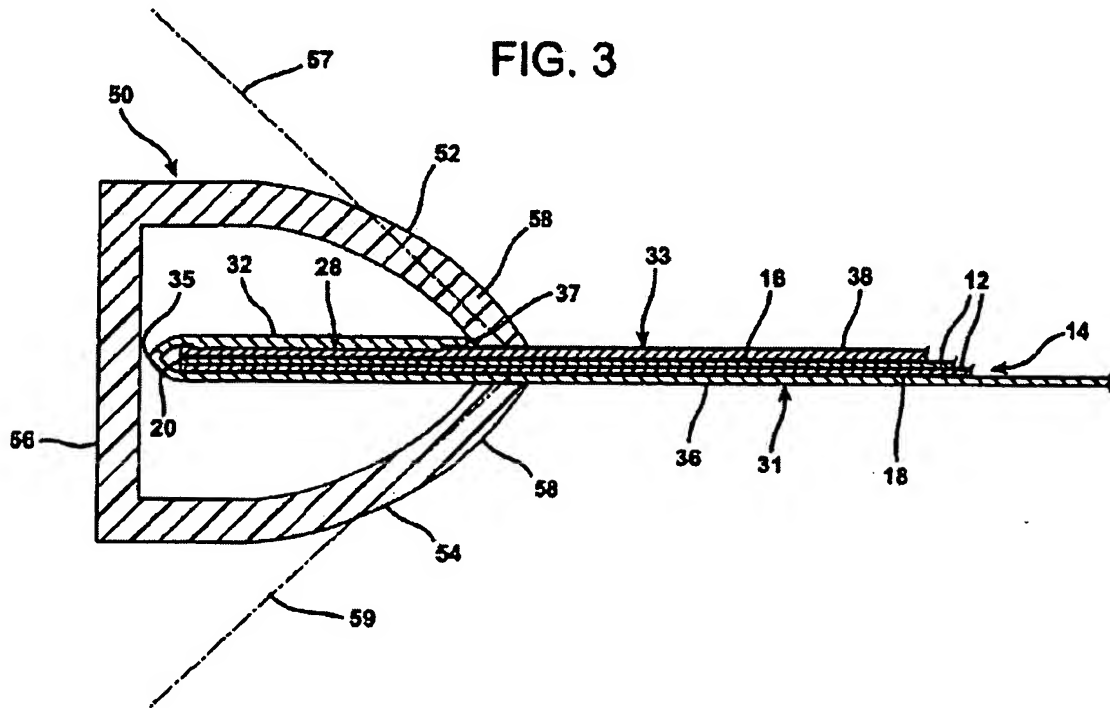
In view of the above amendments and remarks, Applicant respectfully requests the withdrawal of the objections to claims 2 and 4.

Rejections under 35 USC § 102

Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ong (US 6,663,311 B1). Applicant traverses the rejection.

Ong discloses a report cover that includes a sliding bar clamp that is slid onto the papers to be retained. The sliding clamp includes the "stiff, resilient, elongated clasp

Applicant suggests that the clasp of Ong fails to anticipate the binder clip of claim 4.



As recited in instant claim 4, the claimed binder clip includes

- 1) two limbs; and
- 2) a pre-tensioned back configured to apply a force to the limbs;

where the clip is configured to be U-shaped with the limbs parallel to each other in a relaxed state; each limb includes a small inward fold of less than 90 degrees, each inward fold defining a fold line; the fold line being disposed at an acute angle with respect to the back, or the fold being disposed at the region of each limb furthest from

the back.

The Examiner suggests that curved portion 58 of the Ong clamp corresponds to a small fold of less than 90 degrees. Applicant respectfully disagrees, as portion 58 of the Ong clamp curves smoothly, and fails to define a fold line, as recited by claim 4.

The Examiner suggests that the back defines a fold line. Applicant respectfully disagrees, as the fold line is defined as being disposed on each limb. The limbs, in turn, are defined as parallel to each other in a relaxed state. If the fold line is present on the back of the clamp, then it is self-evidently *not* simultaneously present on the limb of the clamp.

The Examiner further suggests that the fold line is disposed at an acute angle with respect to the back, or the fold is disposed at each limb vertex. However, the Examiner has previously indicated that the fold line is present *on* the back of the clamp. Applicant suggests the fold line cannot simultaneously be disposed on the back *and* disposed at an acute angle to the back, and certainly cannot be disposed at a point furthest from the back.

The differences between the Ong clamp and the claimed binder clip are substantive, and go beyond simple design choice. The instant binder clip is intended to hold papers securely, while still offering ease of removal. The clamp of Ong on the other hand, is designed to bind a report in a semi-permanent fashion and eliminate the need for staples. The Ong binder is therefore designed for maximal retention of paper, and not ease of placement and removal. By incorporating the features recited in claim 4, however, the instant clamp holds papers securely while *a/so* permitting the binder clip to be readily engaged and disengaged.

In order to anticipate a claim, a single reference must disclose each and every element of the claim, as it is set out in the claim itself. Ong fails to disclose a clamp having limbs that are parallel to each other in a relaxed state; fails to disclose a clamp where each limb includes a small inward fold of less than 90 degrees; fails to disclose a clamp wherein each fold line is disposed at an acute angle (4a) with respect to the back; and/or fails to disclose a clamp having a fold line disposed at the region of each limb furthest from the back.

For at least these reasons, Applicant respectfully requests that the rejection of claims 2 and 7 under 35 U.S.C. § 102 be withdrawn.

Rejections under 35 USC § 103

Claims 2, 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ong in view of Burleigh et al. (US 2,310,835).

The Examiner asserts that Ong discloses a clip having all the features of claim 4, and that it would have been obvious to one having ordinary skill in the art at the time of the invention to arrange on top of each other and parallel to each other in a state with a clamped stack of sheets by means of a spring as taught by Burleigh in the clip disclosed by Ong, as by doing so, it allows the limbs to be parallel to each other at all times while providing a firm grip in the sheets. Applicant respectfully disagrees.

For at least the reasons provided above, Ong fails to disclose the binder clips of claim 4. Applicant suggests that even in combination with Burleigh, the resulting clamp fails to disclose each and every element of the claims. For example, neither Ong nor Burleigh disclose a clip having an inward fold disposed at an acute angle with respect to the back, or disposed at the region of each limb furthest from the back. With respect to

Burleigh, the gripper portions 4 of the Burleigh mail holder are "flared outwardly to form, with the upper edge of the oppositely disposed gripper, open lips 5 between which letters, billheads and the like may be inserted therebetween without the necessity of spreading apart the grippers themselves" (col. 2, lines 7-12). Furthermore, the Burleigh clip is intended to gently hold letters or other stackable papers in a manner "permitting the withdrawal of one or more letters from the stack without disturbing the position of the remainder" (col. 1, lines 9-17).

This relatively loose and non-binding mail holder of Burleigh is the antithesis of the semi-permanent sliding bar clamp of Ong, which is intended to clamp papers so securely that staples are rendered unnecessary.

Applicant suggests that one of ordinary skill would not combine the mail holder of Burleigh with the report cover of Ong, as doing so would destroy the stated advantages possessed by the Burleigh mail holder. Where a proposed modification changes the principle of operation of a reference, or renders the prior art unsatisfactory for its intended purposes, there can be no motivation to modify the reference as suggested by the Examiner (MPEP § 21043.01).

In view of the above remarks and amendments, Applicant respectfully requests the withdrawal of the rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 103.

New Claim

Applicant takes this opportunity to add new claim 8. Claim 8 corresponds to claim 4, excepting that the recited clip includes fold lines disposed at an acute angle with respect to the back. Applicant respectfully suggests that in view of the above remarks,

the subject matter of claim 8 is similarly neither anticipate nor rendered obvious in view of the prior art of record.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, Applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being transmitted electronically via the United States Patent and Trademark Office's EFS-Web System on April 7, 2008.

Allison M. Deverman Vietor

Allison M. Deverman Vietor

Respectfully submitted,

KOLISCH HARTWELL P.C.

Anton E. Skaugset

Anton E. Skaugset

Registration No. 38,617

Customer No. 23581

Agent for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679